

### R E M A R K S

Claims 1-15 and 17-28 are pending in this application. In the pending office action:

1) claims 1, 3-14, 17, and 19-28 were rejected under 35 U.S.C. § 102(a) in view of U.S. Patent No. 6,879,697 (Topholm) (office action, ¶ 3); and

2) claims 2, 15, and 18 were rejected under 35 U.S.C. § 103(a) in view of the same reference (office action, ¶ 4).

Although the action was made final, this was premature, as the requirements for doing so after a matter has been appealed have not been satisfied. M.P.E.P. § 1207.04 (applicants have neither amended the claims nor submitted an information disclosure statement since issuance of the final office action mailed 12/15/04). Therefore, the applicants traverse the finality of the rejection. Reconsideration is respectfully requested.

#### The Invention

A hearing instrument that resides at least partly in the ear canal must be precisely sized to fit properly and avoid creating discomfort for the user. Such an instrument is fabricated in part by initially creating a virtual or digital representation of the instrument shell and adjusting the fit of the digital representation of the outer surface of the shell in a digital representation of the ear canal.

#### The Newly-Cited Reference Fail to Teach All of the Claim Elements

All of the pending claims were rejected on the basis of Topholm under either 35 U.S.C. § 102 or 35 U.S.C. § 103(a). To sustain a rejection under § 102, "the reference must teach every element of the claim." M.P.E.P. § 2131 (8th ed., rev. 4, October 2005), page 2100-76. The M.P.E.P. goes on to state that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

single prior art reference," quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Similarly, "to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." M.P.E.P. § 2143.03 (8th ed., rev. 4, October 2005), p. 2100-139, citing In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Because the cited reference fails to teach all of the elements of the claims, the reference neither anticipates nor renders the claimed invention obvious.

Each of the three independent claims (1, 17, and 28) contain limitations directed to adjusting the fit of the instrument shell in the ear in the digital domain. More particularly, each of these claims contains the limitation of "adjusting the fit of the digital representation of the outer surface of the shell in the digital representation of the ear canal." At the very least, Topholm lacks this aspect -- the sections of Topholm referenced in the office action (column 7, lines 43-46 and 53-56) do not disclose the claimed subject matter. Therefore, the reference neither anticipates the claims nor renders them obvious.

The foregoing holds true as well for related U.S. Patent No. 6,920,414, issued on July 19, 2005 to the same inventor, Topholm. Having nearly the identical detailed description, this reference came to applicants' attention as a result of the new citation in the 12/01/05 office action, but it too fails to disclose the applicants' claimed subject matter. An information disclosure statement listing this reference accompanies this response.

### Conclusion

The applicants believe that they have responded to all of the issues raised in the office action and submit that all of the pending claims are allowable. Thus, it is respectfully

requested that the examiner pass the application to allowance. The examiner is invited to call the undersigned if there are any questions concerning the application.

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Respectfully submitted,



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